

App. No. 09/874,481

Provisional election under 37 CFR §1.143
Preliminary amendment under 37 CFR §1.115**REMARKS**

Claims 1-44 are pending in the instant application. Claims 1, 9-12, 19, 23, 31-34, and 41 are independent claims. Claims 7, 8, 11, 13, 14, 19-22, 29, 30, 33, 35, 36, 38, and 41-44 have been amended.

Restriction/Election

In the requirement for restriction dated 09/30/2004, Applicant has restricted the claims of the instant application into two groups:

- Group I (Claims 1-22) drawn to a data processing system performing an automated financial or business method, practice, or task; and
- Group II (Claims 23-44) drawn to a method of data processing comprising generating data base or database structure (e.g. via user interface).

Applicant hereby elects Group II (Claims 23-44) drawn to a method for further prosecution, with traverse.

Examiner has asserted that the inventions are distinct because "the process as claimed can be practiced by another, materially different apparatus, or by hand, such as by hand." However, the steps recited in Claims 23-44 explicitly recite "under control of the programmed processor, the processor being programmed therefor". Many steps recited in Claims 23-44 also recite the word "automatically" to modify the verb of the given step. Therefore, the method *as claimed* could not be performed by hand. Applicant respectfully submits that the restriction requirement is improper, and respectfully requests its withdrawal.

Claim Amendments

In a case recently decided by the United States Court of Appeals for the Federal Circuit (CAFC), certain language in one of the patents at issue, similar to language originally employed in some of the claims of the instant application, has been construed in a manner differing from that intended by the Applicants. It is not clear whether the CAFC claim construction is specific to the fact patterns of the decided case, or may be applied more generally. Accordingly, the claims in question have been amended so as to ensure that the claims will be construed in the manner originally intended by the Applicants.

The recently-decided case is *Superguide Corporation v. Directv, Inc.* (CAFC 02-1561, -1562, and -1594, decided 02/12/2004). At least within the context of

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Superguide, the Court has interpreted "at least one of" followed by a conjunctive list of items in the patent in suit (US 5038211) to mean at least one of *each* item in the list. In the instant application, the Applicants intended "at least one of" followed by such a list to mean at least one item *from* the list. Since the claim construction of the CAFC in *Superguide* may at least raise the possibility of a narrower claim construction than that intended by the Applicants, Claims 7, 8, 11, 13, 14, 19-22, 29, 30, 33, 35, 36, and 41-44 have been amended. In each instance, the phrase "at least one of" has been deleted, and the conjunction "and" in the subsequent pair or list of items has been replaced by the conjunction "or". The conjunction "or" is to be construed inclusively (e.g., "a dog or a cat" would be interpreted as "a dog, or a cat, or both"; Bryan A. Garner, Elements of Legal Style p. 103, 2nd ed. 2002), unless: i) it is explicitly stated otherwise, e.g., by use of "either-or", "only one of", or similar language; or ii) two or more of the listed alternatives are mutually exclusive within the context of the claim, in which case "or" would encompass only those combinations involving non-mutually-exclusive alternatives. Applicants believe that this amendment does not change the scope of the amended claims from the originally intended scope, nor is the amendment related to patentability. In particular, the amendments set forth herein are not narrowing amendments.

Claim 38 has been amended to correct a typographical error.

Conclusion

In view of the above, it is submitted that provisionally elected Claims 23-44 are ready for examination. Applicant respectfully requests withdrawal of the restriction requirement and examination of Claims 1-22 as well. Allowance of Claims 1-44 at an early date is earnestly solicited.

Respectfully submitted,



David S. Alavi
3762 West 11th Ave.
#408
Eugene, OR 97402

Reg. No. 40,310
541-686-9462 voice
800-853-6150 fax
dalavi@northwestpatent.com

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